

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-7, 22-31, 42 and 49-56 are pending in this Application. Claims 8-21, 32-41, and 43-48 were previously canceled and Claim 50 is presently canceled without prejudice or disclaimer. Claims 1, 3-7, 22, 24-27, 29-31, 42, 49, and 51-55 have been amended without the introduction of any new matter. Note, for example, FIG.1 (also note, for example, page 13, line 14-page 14, line 22), FIG. 8 (also note, for example, page 14, line 20-page 15, line 23), FIGS. 18-21 (also note, for example, page 36, line 1 – page 41, line 14), and FIGS. 22-23 (also note, for example, page 42, line 6-page 45, line19).

The outstanding Action presents a rejection of Claims 1-7, 22-31, 42, and 49-56 under 35 U.S.C. § 103(a) over Izuka (U.S. Patent No. 5,552,228) in view of Ikegame (JP 10-116431), a rejection of Claims 7 and 26 under 35 U.S.C. § 103(a) over Izuka in view of Ikegame and further in view of Kubo (JP 07-105552).

Turning to the rejection of independent Claims 1 and 42, it is noted that is admitted by the outstanding Action that Izuka does not teach any tilt coil. In order to find a teaching of the missing tilt coil, the out standing Action relies on Ikegame, at paragraph [0028], Fig 12, reference Nos. 5, 6 and an assertion that Ikegame teaches a coil unit comprising a “laminated” structure as to this paragraph [0028] and Fig. 12, reference Nos. 23, 24. However, Fig. 12 and paragraph [0028] clearly teach the need for two different laminate structures (printed coil 23 and printed coil 24) that are operative in two different gaps of two different magnetic circuits. There is no reasonable teaching or suggestion in Ikegame pointing to the subject matter of Claim 1 or that suggests some reasonable modification to Izuka without changing the basic operating principles of Izuka and requiring a redesign to augment the dual gaps and dual laminated structures of Ikegame. In this regard, these relied upon features of Ikegame

are incompatible with the teachings of Izuka as well as the subject matter of independent Claims 1 and 42.

A suggested combination of references that requires a substantial reconstruction and redesign of elements as well as a change of basic principles of operation cannot result in a determination of obviousness. In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959). A prior art reference must be considered as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock Inc., 721 F.2d 1540, 1552, 220 USPQ 303, 311 (Fed. Cir. 1983) cert. denied 469 U.S. 851 (1984). See also M.P.E.P. §§ 2141.02(VI), 2143.01(V) and 2145(X)(D).

Claims 2-7, 49, 55, and 56 depend from respective ones of these independent claims and, thus, clearly distinguish over Izuka and/or Ikegame considered alone or in any proper combination for the same reasons as their respective independent claim. In addition, reliance on one foreign document to establish art recognized equivalence in the U.S. is believed to be an error as to the rationale offered to reject dependent Claim 7 over Izuka in view of Ikegame.

With additional regard to Claim 7 and the added reliance on Kubo to compensate for the lack of evidence from the U.S., Kubo does not cure the deficiency noted above as to the basic incompatibility of the primary references to Izuka and Ikegame.

Accordingly, the withdrawal of the rejection of Claims 1, 2-7, 42, 49, 55, and 56 over Izuka in view of Ikegame and the rejection of Claim 7 over Izuka in view of Ikegame and further in view of Kubo is respectfully requested.

With regard to the rejection of independent Claim 22 over Izuka in view of Ikegame, it is noted that neither of these references teach the use of focus coils to provide focus adjusting movements of a laminate structure due to “a sum of drive forces generated relative to the plurality of focus coils in response to respective currents supplied to the plurality of

focus coils interacting with the magnetic field of the gap” while also providing “inclination adjustment of the objective lens by generating a moment around a center of gravity of a movable part due to a difference between the drive forces.” Accordingly, as it is well established that a *prima facie* case of obviousness requires that all claim limitations be considered and demonstrated to be taught or suggested by the prior art, see MPEP §2143.03, withdrawal of this improper rejection of independent Claim 22 is respectfully requested.

Claims 23-26, 51, and 52 depend from independent Claim 22 and, thus, clearly distinguish over Izuka and/or Ikegame considered alone or in any proper combination for the same reasons as independent Claim 22 does. In addition, reliance on one foreign document to establish art recognized equivalence in the U.S. is believed to be an error as to the rationale offered to reject dependent Claim 26 over Izuka in view of Ikegame.

With additional regard to Claim 26 and the added reliance on Kubo to compensate for the lack of evidence from the U.S., Kubo does not cure the deficiency noted above as to the failure of the primary references to Izuka and Ikegame to teach all of the limitations of base independent Claim 22.

Accordingly, the withdrawal of the rejection of Claims 22-26, 51, and 52 over Izuka in view of Ikegame and the rejection of Claim 26 over Izuka in view of Ikegame and further in view of Kubo is respectfully requested.

Turning to the rejection of independent Claim 27 over Izuka in view of Ikegame, it is noted that once again it is clear that these references taken alone or in combination fail to teach all the limitations of this base independent Claim 27. For example, Claim 27 requires “a plurality of tracking coils configured to provide tracking adjusting movements” and then requires that this is due to “a sum of drive forces generated relative to the plurality of tracking coils in response to respective currents supplied to the plurality of focus coils interacting with the magnetic field of the gap.” At the same time, these tracking coils also produce

“inclination adjustment of the objective lens by generating a moment around a center of gravity of a movable part due to a difference between the drive forces.”

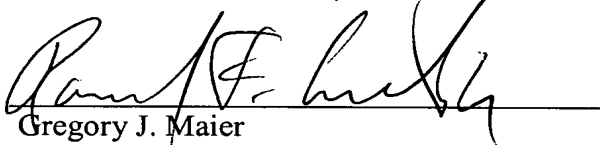
Claims 28-31, 53 and 54 depend from independent Claim 27 and, thus, clearly distinguish over Izuka and/or Ikegame considered alone or in any proper combination for the same reasons as independent Claim 27 does.

Accordingly, the withdrawal of the rejection of Claims 27-31, 53, and 554 over Izuka in view of Ikegame and the rejection of Claim 26 over Izuka in view of Ikegame and further in view of Kubo is respectfully requested.

Accordingly, as no other issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Raymond F. Cardillo, Jr.
Registration No. 40,440